

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LINDA P. THORNE, THOMAS J. POLLOCK,
and RICHARD W. ARMENTROUT

Appeal No. 95-4440
Application 07/841,707¹

HEARING: March 9, 1999

Before GRON, ELLIS, and LORIN, Administrative Patent Judges.

GRON, Administrative Patent Judge.

DECISION ON APPEAL UNDER 35 U.S.C. § 134

This is an appeal under 35 U.S.C. § 134 of an examiner's

¹ Application for patent filed February 26, 1992.
According to appellants, this application is a division of
Application 07/777,151, filed October 16, 1991, now pending.

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rejections of Claims 19 and 20, the only claims remaining in this application.

Introduction

Claims 19 and 20 stand rejected under 35 U.S.C. § 102(a) as being anticipated by, or under 35 U.S.C. § 103 as being unpatentable in view of, Böck et al. (Bock), U.S. 5,019,514, patented May 28, 1991. Claims 19 and 20 also stand rejected under 35 U.S.C. § 102(b) as being anticipated by, or under 35 U.S.C. § 103 as being unpatentable in view of, Kato et al. (Kato), U.S. 3,931,146, patented January 6, 1976; Leathers et al. (Leathers), "Pullulan Production by Color Variant Strains of *Aureobasidium pullulans*," Journal of Industrial Microbiology, Vol. 3, pp. 231-239 (1988); Wickerham et al. (Wickerham), "Synergistic Color Variants of *Aureobasidium Pullulans*," Mycologia, Vol. 67, pp. 342-361 (1975); Na et al. (Na), "Screening of Strains Producing Extracellular Polysaccharides of No Pigments and Determination of Their Products," Weishengwuxue Tongbao, Vol. 17, pp. 7-9 (1990); or Kelly et al. (Kelly), "The Effect of Ethidium Bromide Mutagenesis on Dimorphism, Extracellular Metabolism and Cytochrome Levels in *Aureobasidium pullulans*," Journal of

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General Microbiology, Vol. 102, pp. 249-254 (1977). Claims 19
and 20 read:

19. An isolated substantially biologically pure microbial culture selected from the group consisting of those having the following identifying characteristics: *A. pullulans* ATCC 74100, *A. pullulans* ATCC 74101, *A. pullulans* 74102, *A. pullulans* 74103, *A. pullulans* 74104, and *A. pullulans* 74105, and mutants thereof, said culture being capable of reproducing itself and of producing substantially non-pigmented pullulan having an M_w of at least 6×10^6 in isolatable amounts when cultured in a liquid growing medium containing assimilable sources of carbon, nitrogen, and inorganic substances.

20. Isolated substantially biologically pure microbial cultures selected from the group having the following identifiable characteristics: *A. pullulans* ATCC 74100, *A. pullulans* 74101, and *A. pullulans* 74105, and mutants thereof, said culture being capable of reproducing itself and capable of producing substantially non-pigmented pullulan having an M_w of at least 6×10^6 in isolatable amounts when cultured under aerobic conditions in a liquid growing medium containing assimilable sources of carbon, nitrogen, and inorganic substances and having DNA restriction patterns of lanes b, c, and d of Figure 2B.

On April 2, 1998, at the request of the Group Director of Technology Center 1600, the Board remanded this application "to the jurisdiction of the patent examiner so that the issues raised in this appeal can be reconsidered" (REMAND TO THE EXAMINER, p. 1 (Paper No. 22)). In a "communication from the EXAMINER" entered November 30, 1998 (Paper No. 23), the

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examiner stated (p. 2):

Pursuant to the Remand under 37 CFR 1.193(b)(1) by the Board of Patent Appeals and Interferences on April 2, 1998, a supplemental Examiner's Answer is set forth below:

Upon further consideration, the rejections of claims 19-20 under 35 USC 102 (a or b) and under 35 USC 103 still stand only insofar as the mutant strains are concerned.

The difference between the claimed mutant strains and the strains disclosed by the prior art of record cannot [be] ascertained.

Discussion

The "supplemental Examiner's Answer" leaves this panel perplexed. The examiner previously found that the *A. pullulans* strains and mutants disclosed by Bock, Kato, Leathers, Wickerham, Na, and Kelly anticipate one or more of appellants' *A. pullulans* ATCC 74100, *A. pullulans* ATCC 74101, *A. pullulans* ATCC 74102, *A. pullulans* ATCC 74103, *A. pullulans* ATCC 74104, and *A. pullulans* ATCC 74105, because (1) Bock's *A. pullulans* strain 56 is "capable of producing pullulan having a lower quantity of melanin" (Examiner's Answer (Ans.), p. 3, 2nd full para.); (2) Kato's *A. pullulans* strains IFO 4464, IFO 4875, IFO 6353, IFO 6401, IFO 6402, and IFO 6725 . . . [are] "capable of producing

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pullulan which upon hydrogenation has an average mw of 5×10^6 "

(Ans.,

pp. 3-4, bridging para.); (3) Leathers' *A. pullulans* strains

are "capable of producing pullulan" (Ans., p. 4, 1st full

para.); (4) Wickerham's *A. pullulans* strains are "capable of

producing pullulan" (Ans., p. 4, 2nd full para.); (5) Na's *A.*

pullulans strain A22 is "capable of producing unpigmented

pullulan" (Ans., p. 4, 3rd full para.); and (6) Kelly's *A.*

pullulans mutants are "capable of producing pullulan" (Ans.,

p. 4, 4th full para.). Even then, appellants' claimed *A.*

pullulans strains with specified characteristics are

practically impossible to compare to the *A. pullulans* strains

and mutants with unspecified characteristics which are in the

public domain. While the strains appellants claim and those

the prior art discloses have the common genus *A. pullulans*,

the prior art strains may or may not produce "substantially

non-pigmented pullulan having an M_w [molecular weight] of at

least 6×10^6 in isolatable amounts" (Claim 19). The question

the examiner properly raised was whether or not the prior art

disclosures of strains of a common genus which (1) produce

unpigmented pullulan or pullulan having a lower quantity of

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melanin at best and pullulan at least, and/or

(2) produce hydrogenated pullulan having an average molecular weight of 5×10^6 at best and pullulan at least, are

sufficient to shift the burden to appellants to show that the claimed and

prior art strains are not the same or substantially the same.

We emphasize the word "was" because of the examiner's most recent findings and conclusions that the rejections stand only insofar as the mutant strains are concerned.

The examiner has apparently now decided that the prior art disclosures of strains having a common genus which (1) produce unpigmented pullulan or pullulan having a lower quantity of melanin at best and pullulan at least, and/or (2) produce hydrogenated pullulan having an average molecular weight of

5×10^6 at best and pullulan at the very least, are not sufficient to shift the burden to appellants to show that the claimed *A. pullulans* strains and the prior art *A. pullulans* strains are not the same or substantially the same. More pertinent to the issues presently before us, whatever characteristics the prior art attributes to the pullulan which the *A. pullulans* strains it discloses produce, we find even

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less disclosure of any characteristics which are attributable to pullulan produced by mutants of the *A. pullulans* strains which the prior art discloses. Moreover, the examiner now states (communication from the EXAMINER in charge (Paper No. 23), p. 2, para. 2), "The difference between the claimed mutant strains and the strains disclosed by the prior art of record cannot [be] ascertained." Accordingly, faced with the initial burden to establish a prima facie case of unpatentability under 35 U.S.C.

§ 102 or 103, the examiner now points to less evidence than that evidence which had been relied upon to support the rejection which the examiner withdrew.

We are constrained to reverse the examiner's rejections. The examiner has the initial burden to establish unpatentability. The rejections in this case are not supported by sufficient

evidence. In re Wilder, 429 F.2d 447, 166 USPQ 545 (CCPA 1970), places cases such as the one before us in proper perspective at 450, 166 USPQ at 548:

If an applicant had to prove novelty before he could

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obtain a patent he would have an almost insurmountable burden. Therefore, the statute provides for what may be said to be a presumption of novelty in the language of section 102 "a person shall be entitled to a patent *unless _ _ _*" (Emphasis added). What this means, in an ex parte proceeding to obtain a patent, is that the Patent Office has the initial burden of coming forward with some sort of evidence tending to disprove novelty.

Conclusion

We reverse all the examiner's rejections of Claims 19 and 20 under 35 U.S.C. § 102 or 103.

REVERSED

	Teddy S. Gron)	
	Administrative Patent Judge)	
)	
)	
)	
	Joan Ellis)	BOARD OF
PATENT)	
	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
	Hubert C. Lorin)	
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